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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/692,275	10/22/2003	Tomoya Misato	51417/DBP/A400	7139

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EXAMINER

BELL, KENT L

ART UNIT	PAPER NUMBER
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1661

DATE MAILED: 03/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/692,275

Applicant(s)

MISATO ET AL.

Examiner

Kent L. Bell

Art Unit

1661

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to application filed 10/22/03 communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10/22/03 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: ____.

K. L. Bell

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Objection to the Drawing

The following is a quotation of section (a) of 37 CFR 1.165:

(a) Plant patent drawings are not mechanical drawings and should be artistically and competently executed. Figure numbers and reference characters need not be employed unless required by the Examiner. The drawing must disclose all the distinctive characteristics of the plant capable of visual reproduction.

The submitted photographic illustrations filed October 22, 2003 are objected to under 35 CFR 1.165(a). By way of explanation, the photographic illustrations should not be mounted (37 CFR 1.84(e)).

The rules for submitting drawings, 37 CFR 1.84 and 37 CFR 1.165, were amended effective November 29, 2000. The USPTO delayed enforcement of these changes until October 1, 2001. Complete details can be found in the May 22, 2001 *Official Gazette* (1246 OG 106-107) or on the Internet at: <http://www.uspto.gov/web/offices/com/sol/og/2001/week21/patwavr.htm>.

Objection to the Disclosure

37 CFR 1.163

The following is a quotation of section (a) of 37 CFR 1.163:

(a) The specification must contain as full and complete a disclosure as possible of the plant and the characteristics thereof that distinguish the same over related known varieties, and its antecedents, and must particularly point out where and in what manner the variety of plant has been asexually reproduced. In the case of a newly found plant, the specification

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must particularly point out the location and character of the area where the plant was discovered.

35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

As specific to United States Plant Patent applications, the specifics of 37 CFR 1.164 (reproduced below) are controlling:

The claim shall be in formal terms to the new and distinct variety of the specified plant as described and illustrated, and may also recite the principal distinguishing characteristics. More than one claim is not permitted.

In plant applications filed under 35 U.S.C 161, the requirements of 35 U.S.C. 112 are limited. The following is a quotation of 35 U.S.C. 162:

No plant patent shall be declared invalid for noncompliance with section 112 of this title if the description is as complete as is reasonably possible. The claim in the specification shall be in formal terms to the plant shown and described.

The disclosure is objected to under 35 CFR 1.163(a) and under 35 U.S.C. 112, first paragraph, because the specification presents less than a full, clear, and complete botanical

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description of the plant and the characteristics which define same per se and which distinguish the plant from related known cultivars and antecedents.

More Specifically:

A. Page 1, lines 4 and 5, Applicants set forth the species involved with the parentage of the instant plant. As written it appears that three plants were crossed. However, applicants state on lines 13 and 14 of the same page the female parent plant is *Mandevilla atrovioleacea* and the male parent plant is *Mandevilla amabilis x boliviensis*. As written it appears the female parent plant is a single species and the male parent plant is a cross between two different species. Applicants should clearly set forth in the specification the instant plant's Genus/species. It appears - *Mandevilla atrovioleacea x (Mandevilla amabilis x boliviensis)*- - is the instant plant's Genus/species since these are the species of the two parental cultivars. If accurate, such should be inserted at lines 4 and 5 of page 1 to clearly and accurately set forth the instant plant's Genus/species.

B. Page 1, line 12, Applicants should delete the first recitation of "a".

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C. Page 1, lines 12 and 13, Applicant should set forth in the specification the name of the female parent plant, if named. If unnamed, applicant should delete the second recitation of "a" on line 12 and insert - -an unnamed- -.

D. Page 1, line 23, Applicant should delete "petal" and insert - -petals- -.

E. Page 1, line 34, Applicant should delete the double quotation marks around the two cultivar names and insert single quotation marks as this is the proper way to set forth a cultivar name.

F. Page 2, lines 1 and 2, Applicants state the instant cultivar is "uniform and stable in its characteristics". However, this recitation does not mean the instant plant reproduces true to type in successive generations of asexual reproduction. If the plant does reproduce true to type then applicant should also state in the specification - -The new variety reproduces true to type in successive generations of asexual reproduction.- -. If the plant does not reproduce true to type then applicants will be unable to obtain a U.S. Plant Patent on this particular cultivar.

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G. Page 2, line 13, page 4, line 25, and page 6, line 36, Applicants should delete "at the SUNTORY FLOWERS Ltd.," as this recitation constitutes unwarranted advertising (MPEP 1610). The current recitation without the recitation stated above is more than adequate.

H. Page 9, lines 8 and 9, Applicants should delete "at the afore-mentioned Suntory Flowers Ltd.," as this recitation constitutes unwarranted advertising (MPEP 1610). The current recitation without the recitation stated above is more than adequate.

I. Page 9, line 28, Applicants should insert - -a- - after "is".

J. Page 9, line 30, Applicants should delete "flower" and insert - -flowers- -.

K. Page 9, lines 35-37, Applicants should set forth in the specification the age when the plant was described and container size, if grown in a container.

L. Page 9, lines 35-37, Applicants should set forth in the specification the location where the instant plant was described.

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M. Page 10, line 2, Applicants should set forth in the specification additional information relative to the instant plant including the typical and observed height and diameter.

N. Page 10, lines 4-6, Applicants should set forth in the specification additional information relative to the instant plant's stem including the typical and observed stem length.

O. Page 10, line 13, Applicants state leaf apex is "Mucrodate". Applicants should verify the leaf apex descriptor.

P. Page 10, lines 32 and 33, Applicants should set forth in the specification additional information relative to the instant plant's bud including the typical and observed length, diameter, and shape.

Q. Page 11, line 1, Applicants state flower shape is "Single". Single is not a flower shape. Applicants should set forth in the specification the typical and observed flower shape.

R. Page 11, line 6, Applicants should set forth in the specification additional information relative to the instant plant's floral tube including the typical and observed floral tube diameter.

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S. Page 11, line 7, Applicants state "Coluor". Applicants should delete this recitation and insert - -Colour- - in its place as this is the correct spelling.

T. Page 11, line 11, Applicants state "outside". This recitation is unclear as it is not understood whether applicant is intending "outside" to mean - -under side- -. The term "under side" would be more meaningful in this instance. Correction and/or clarification is necessary.

U. Page 11, line 13, Applicants state "Overlapping of petals.- -Closed.". This recitation is unclear as it is not understood what applicants are intending. Correction and/or clarification is necessary.

V. Page 11, line 17, Applicants should set forth in the specification additional information relative to the instant plant's petals including the typical and observed petal margin descriptor. The recitation "Waving of petal.- -Medium" simply means the petal is wavy it does not describe the petal margin.

W. Page 11, line 21, Applicants state "Type of sepal.- -Open.". This recitation is unclear as it is not understood what applicants are intending. Correction and/or clarification is necessary.

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X. Page 11, line 21, Applicants should set forth in the specification additional information relative to the instant plant's sepals including the typical and observed sepal number, length, width, shape, apex, base, and margin descriptor, and coloration (both surfaces) with reference to the employed color chart.

Y. Page 12, lines 3 and 4, Applicants state Cold tolerance is "Medium" and Heat tolerance is "High". Applicants should set forth in the specification meaningful information relative to the instant plant's Cold and Heat tolerance such as a USDA Hardiness Zone. The recitations "Medium" and "High" are vague and insufficient in this regard.

Z. Page 12, lines 5 and 6, Applicants state Resistance to diseases and pests is "Medium". Applicants should set forth in the specification meaningful information relative to the instant plant's Resistance to diseases and pests such as stating which disease and pests the instant plant is resistant or susceptible to. The recitation "Medium" is vague and insufficient in this regard.

AA. If produced, information relative to the instant plant's seed should be set forth in the specification including the typical and observed seed number, size, and coloration with reference to the employed color chart.

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AB. If produced, information relative to the instant plant's pedicel should be set forth in the specification including the typical and observed pedicel length, diameter, and coloration with reference to the employed color chart.

The above listing may not be complete. Applicants should carefully review the disclosure and import into same any corrected or additional information which would aid in botanically identifying and/or distinguishing the cultivar for which United States Plant Patent protection is sought.

Claim Rejection

35 U.S.C. 112, 1st & 2nd Paragraphs

Claim 1 is rejected under 35 U.S.C. 112, first and second paragraphs as not being supported by a clear and complete botanical description of the plant for the reasons set forth in the Objection to the Disclosure Section above.

Comments

Applicants should note the new amendment format which is now mandatory (Web site stated below).

<http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/revamdtprac.htm>

Detailed Action

Applicants should send all correspondence to the following address:

COMMISSIONER FOR PATENTS
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450

Future Correspondence

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Kent L. Bell whose telephone number is (571) 272-0973. The Examiner can normally be reached Monday through Thursday from 6:00 am to 4:30 pm.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Bruce Campell, can be reached at (571) 272-0974.

The fax phone number for the group is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

K. L. Bell

KENT BELL
PRIMARY EXAMINER

Kent L. Bell